

**REMARKS**

Claims 1-26 were pending in this application.

Claims 1-26 have been rejected.

No claims have been currently amended.

Claims 1-26 remain pending in this application.

Reconsideration and full allowance of Claims 1-26 are respectfully requested.

**I. AMENDMENT TO THE SPECIFICATION**

The specification has been amended to correct typographical errors in some reference numerals. No new matter has been added to the specification as a result of this amendment.

**II. AMENDMENT TO THE DRAWINGS**

FIGURE 2 has been amended to correct typographical errors in the reference numerals in flow diagram 200. No new matter has been added as a result of this amendment to the drawing.

**III. REJECTIONS UNDER 35 U.S.C. § 103**

The June 1, 2006 Office Action rejects Claims 1-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0106997 to Barber et al. (“*Barber*”) in view of U.S. Patent Application Publication No. 2002/0016189 to Sheynblat et al. (“*Sheynblat*”) and further in view of U.S. Patent No. 5,940,742 to Paul W. Dent (“*Dent*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed.Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed.Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the

prior art, and not based on the applicant's disclosure. MPEP § 2142.

The *Barber* reference recites a method and apparatus for extending the battery life in a radio frequency wireless modem 100. (*Barber*, Abstract). The modem 100 is capable of operating in a normal power mode and a low power sleep mode. (*Barber*, Paragraph [0064]). The modem 100 also includes two timers 440, 445. (*Barber*, Paragraph [0074]). The first timer 440 determines the amount of time that the modem 100 attempts to register with a base station controller. (*Barber*, Paragraph [0074]). After the first timer 440 expires, the modem 100 enters the low power sleep mode. (*Barber*, Paragraph [0074]). The second timer 445 determines the amount of time that the modem 100 remains in the low power sleep mode. (*Barber*, Paragraph [0074]).

The *Barber* reference simply recites that the wireless modem may enter a low power sleep mode in response to a timer elapsing. *Barber* also recites that the wireless modem may leave the low power sleep mode in response to another timer elapsing. *Barber* lacks any mention of a plurality of low power modes. *Barber* lacks any mention that only timer 440 or only timer 445 receives power when the wireless modem operates in the low power sleep mode.

The *Sheynblat* reference recites an apparatus for monitoring the battery level in a portable cellular transceiver. (*Sheynblat*, Abstract). A comparator compares the battery level to one or more thresholds, and the portable cellular transceiver enters at least one low power mode. (*Sheynblat*, Abstract and Paragraph [0029]). Various low power modes are described in *Sheynblat*, including low power modes that provide enough power for: placing a call of a limited duration, initiating a call, receiving a call, or placing an emergency call.

(*Sheynblat*, Paragraph [0029]).

The *Sheynblat* reference recites that the portable cellular transceiver may enter one or more low power modes in response to certain battery levels. *Sheynblat* lacks any mention that only a timer receives power when the portable cellular transceiver operates in one of the low power modes. In fact, *Sheynblat* does not appear to describe any timers in the portable cellular transceiver.

For these reasons, the June 1, 2006 Office Action does not establish that a proposed combination of the *Barber* and *Sheynblat* references discloses, teaches, or suggests all elements of Claims 1, 13, and 25 (and their dependent claims). The June 1, 2006 Office Action stated that “With further respect to claim 1, Barber doesn’t show the claimed first of a plurality of low-power modes. Nonetheless, Sheynblat reveals this limitation (see paragraph 0029). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barber with the modes disclosed in Sheynblat. This modification would have improved the efficiency of Barber by extending battery life in a radio frequency device as suggested by Barber.” (June 1, 2006 Office Action, Page 3, Lines 13-20). For the reasons set forth below, the Applicants respectfully traverse these conclusions of the Examiner.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) (“It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d

1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembicza*k, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Roufett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Applicants respectfully submit that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicants respectfully submit that the alleged motivation to combine references is not clear and particular. The Examiner stated that “This modification would have improved the efficiency of Barber by extending battery life in a radio frequency device as suggested by Barber.” (June 1, 2006 Office Action, Page 3, Lines 18-20). The Applicants respectfully traverse this assertion of the Examiner. The *Barber* reference does not suggest the concept of extending battery life by using a plurality of low power modes. The *Barber* reference

is silent concerning using a plurality of low power modes. The *Sheynblat* reference is silent concerning using timers in a portable communication device. The supposed motivation to combine the *Barber* reference and the *Sheynblat* reference is said to be “improved efficiency.” The Applicants respectfully submit that the supposed motivation of “improved efficiency” is not “clear and particular” and is therefore legally insufficient to serve as a valid motivation to combine the *Barber* reference and the *Sheynblat* reference.

The fact that two references are concerned with the same general technical area (here, radio frequency wireless devices) does not without more provide a “clear and particular” motivation to combine the references. The Applicants respectfully submit that the alleged motivation to combine the *Barber* reference and the *Sheynblat* reference has been assumed by “hindsight” in light of the existence of the Applicants’ invention.

Even if the *Barber* reference could somehow be combined with the *Sheynblat* reference, the combination would not teach, suggest, or even hint at the Applicants’ invention as set forth in Claims 1-26. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant’s disclosure. In the present case, the *Barber* reference and the *Sheynblat* reference in combination would not teach or suggest all the claim limitations of the Applicants’ invention.

The June 1, 2006 Office Action recognized this when it stated that “Further regarding claim 1, Barber mentions the power-saving apparatus comprises a timer (see Figure 4). Barber

does not clearly state that only the timer is capable of receiving power when the RF transceiver is in another of the low-power modes. All the same, Dent shows this feature (see column 4). As a result, it would have been obvious at the time the invention was made to further modify the combination of Barber and Sheynblat with the circuitry of Dent. This modification would have improved the system's efficiency by extending battery life in a radio frequency device as suggested by Barber." (June 1, 2006 Office Action, Page 4, Lines 1-10). The Applicants respectfully traverse these conclusions of the Examiner.

The pager device in the *Dent* reference does not operate continuously. The pager device in the *Dent* reference only operates during certain predetermined time slots in a repetitive frame period. (*Dent*, Column 4, Lines 15-18). There is only one "sleep mode" for the *Dent* pager device. There is not a plurality of sleep modes in the *Dent* pager device. Therefore, the concept of a low-power timer in the *Dent* reference relates only to a single "sleep mode" and not to a plurality of "sleep modes." Therefore, the Applicants respectfully traverse the assertion of the Examiner that the *Dent* reference teaches the concept that "only the timer is capable of receiving power when the RF transceiver is in another of the low-power modes." The *Dent* reference does not teach, suggest or even hint at a timer system that is capable of operating with more than one "sleep mode."

The Applicants respectfully submit that the alleged motivation to combine the teachings of the *Barber* reference and the *Sheynblat* reference and the *Dent* reference that has been presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicants respectfully submit that the alleged motivation to combine

the three references is not clear and particular. The Examiner stated that “This modification would have improved the system’s efficiency by extending battery life in a radio frequency device as suggested by Barber.” (June 1, 2006 Office Action, Page 4, Lines 8-10). The Applicants respectfully traverse this assertion of the Examiner. The *Barber* reference does not suggest the concept of extending battery life by using a plurality of low power modes. The *Barber* reference is silent concerning using a timer where the time is capable of receiving power only when the RF transceiver is in one of a plurality of low-power modes.

The supposed motivation to combine the *Barber* reference and the *Dent* reference is said to be “improved efficiency.” The Applicants respectfully submit that the supposed motivation of “improved efficiency” is not “clear and particular” and is therefore legally insufficient to serve as a valid motivation to combine the *Barber* reference and the *Dent* reference.

The fact that two references are concerned with the same general technical area (here, radio frequency wireless devices) does not without more provide a “clear and particular” motivation to combine the references. The Applicants respectfully submit that the alleged motivation to combine the *Barber* reference and the *Dent* reference has been assumed by “hindsight” in light of the existence of the Applicants’ invention.

Furthermore, the Applicants respectfully submit that the supposed motivation of “improved efficiency” is not “clear and particular” and is therefore legally insufficient to serve as a valid motivation to combine the *Barber* reference and the *Sheynblat* reference and the *Dent* reference. The Applicants respectfully submit that the alleged motivation to combine the *Barber*

reference and the *Sheynblat* reference and the *Dent* reference has been assumed by “hindsight” in light of the existence of the Applicants’ invention.

Furthermore, for the reasons set forth above, the Applicants respectfully submit that the proposed combination of the *Barber* reference and the *Sheynblat* reference and the *Dent* reference would not teach or suggest all the claim limitations of the Applicants’ invention.

For these reasons, the June 1, 2006 Office Action does not establish that a proposed combination of the *Barber* and *Sheynblat* and *Dent* references discloses, teaches, or suggests all elements of Claims 1, 13, and 25 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejections and full allowance of Claims 1-26.

The rejections of Claims 1-26 are respectfully traversed. Accordingly, the Applicants respectfully request withdrawal of the §103 rejections and full allowance of Claims 1-26.

#### IV. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

**SUMMARY**

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@munckbutrus.com](mailto:wmunck@munckbutrus.com).

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

  
\_\_\_\_\_  
William A. Munck  
Registration No. 39,308

Date: September 1, 2006  
P.O. Drawer 800889  
Dallas, Texas 75380  
(972) 628-3600 (main number)  
(972) 628-3616 (fax)  
E-mail: [wmunck@munckbutrus.com](mailto:wmunck@munckbutrus.com)